

REMARKS

This Amendment submitted in response to the Office Action of December 28, 2004 in which claims 1-21 were rejected.

Regarding the objection to claims 5, 6, 7, 8, 12, 14, 15, 19, 20 and 21, please note that the present national stage application entered the U.S. national stage with a Preliminary Amendment to the claims appearing in the 6-sheet annex attached to the International Preliminary Examination Report (Form PCT/IPEA/409) submitted December 28, 2001 with the transmittal letter to the U.S. Designated/Elected Office concerning the national stage entry under 35 U.S.C. § 371. The amendment removed the multiple dependencies by making claims 5-8 depend from claim 1, claims 12, 13, 15 and 16 from claim 10 and claims 19-21 from claim 17. Withdrawal of the objection to these claims is requested.

Regarding the rejection of claim 7 under 35 U.S.C. § 112, second paragraph, the limitation “the enquiry” finds sufficient antecedent basis in claim 1 at line 10 thereof “sending an enquiry”. Withdrawal of the indefiniteness rejection of claim 7 is requested.

Novelty

In Section 5 of the Office Action, the Examiner objected to claim 1 on the grounds of lack of novelty over Chien (U.S. 5,839,072) based on § 102(e). The Examiner cites column 3, line 65 to column 4, line 53 and column 6, line 6-62 of Chien as anticipating claim 1.

Referring to the paragraph beginning at the last line on page 2 of the Office Action and ending at page 3, line 10, it is noted that the Examiner has apparently based the 35 U.S.C. § 102(e) rejection on the text of claim 1 as filed in the Request and published by WIPO under International Publication WO 01/03446. However, the USPTO examination should have been based on the claims 1-21 appearing in the 6-sheet annex attached to the International Preliminary Examination Report, in which the amended sheets 21-26 appear. A copy of the IPER was submitted to the USPTO with the transmittal entering the national stage in the U.S. and filed on December 28, 2001 by Express Mail. Therefore, the Examiner is requested to

review the claims appearing in the amended sheets attached as annexes to the IPER and to reevaluate the rejection of claims 1-21 in light of the language appearing in the claims as amended in the international phase and in light also of the remarks which follow concerning the Chien reference.

Chien relates to a method for transporting a telecommunications signal to a mobile station relocated (ported) from a first HLR to a second HLR. A network address representing an HLR associated with a mobile station is stored in a centralized database. During a setup procedure a signal requesting a network address of the home HLR associated with a mobile station is transmitted to the centralized database, which transmits the network address back to the requesting telecommunications exchange. The call is then routed to the gateway mobile switching center (GMSC) associated with the indicated HLR network address. The GMSC routes the incoming signal to a particular mobile switching center (MSC) according to routing instructions from the HLR. The basis of this method is set out at column 2, lines 25-59 of Chien. The passage cited by the Examiner at column 6, lines 6-62 relates to a more specific embodiment of the method.

Chien does not disclose a method having the following features of claim 1 of the present application:

- the telecommunications system provides at least one supplementary telecommunications service (the method of Chien relates only to routing calls to a ported mobile station and does not refer to the provision of supplementary telecommunication services);
- informing at least one supplementary telecommunications service of the results of said determination during a phase that is before a phase in which the setup procedure is completed and before provision of at least one supplementary telecommunications service for said first station is initiated.

Chien does not relate to the provision of supplementary telecommunications services, and thus there is no disclosure in Chien that such a service is informed of whether the second station is a ported station (see pages 4 and 5 of the present application for an explanation of supplementary telecommunications services). Consequently, Chien makes no disclosure concerning the time at which the

supplementary telecommunications service is informed, which is also specified by claim 1 of the present application.

The passage of Chien cited by the Examiner at column 3, line 65 to column 4, line 53 relates to an embodiment in which a mobile station 30 relocates from a first PLMN 10a to a second PLMN 10b whilst retaining its MSISDN number. However, because the MSISDN number has not been changed, all future incoming calls are still routed to the old PLMN 10a, which cannot re-route the received incoming calls to the relocated mobile station 30 because of the correct HLR storing the subscriber information cannot be determined. Thus, this passage of Chien does not even disclose a number portability service which enables porting of stations from one network to another whilst retaining the original number, as required by claim 1.

Therefore, claim 1 of the present application is not anticipated by Chien. Claims 10 and 17 are also not anticipated for similar reasons.

Regarding the dependent claims 2, 4-8, 10-12 and 14-16 and 18-21, these all depend from independent claims 1, 10 and 17 which have been shown to be novel over the Chien reference and are also novel for at least the reasons advanced above in support of the novelty of the independent claims. Therefore, withdrawal of the novelty rejection of the rejected dependent claims is requested as well.

Non-Obviousness

Claims 3, 9 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentably obvious over Chien as applied to claim 2 and in further in view of U.S. 6,049,714 of Patel.

The advantage of the present invention over that disclosed in Chien is that it improves call handling and management involving supplementary telecommunication services by ensuring that called party information, such as location and the subscribed network, is correct when such a service is initiated (see paragraph bridging pages 10 and 11 of the present application as originally filed). Moreover, the present invention is useful in optimizing the use of call transmitting capacity and enabling a more efficient use of the routing register functionality in future applications. Neither Chien nor Patel show or even suggest a method dealing

with the problem of portability when using supplementary telecommunication services such as those defined in the paragraph bridging pages 4 and 5 of the present application.

The present invention also advantageously ensures that a supplementary service is provided with necessary information regarding the status of the called party before the calling party initiates use of the service and before the setup procedure is completed. This is particularly advantageous with respect to call handling and management, for example in view of call charging and call related signalling and routing. If the supplementary telecommunications service were not informed of whether the second station is a ported station at an early stage, various services such as a pre-paid service would not receive status information at an appropriate time in order to function correctly.

Withdrawal of the 35 U.S.C. § 103(a) rejection of claims 3, 9 and 13 is requested.

Conclusion

The subject matter of the present claims, therefore, provides a number of advantages which are not shown or even suggested by the applied prior art. It is submitted that a skilled person would have no motivation to use a method as defined in claims 1, 10 or 17 of the present application, much less the dependent claims, and that therefore the present claims should not be considered to lack novelty or to be obvious.

The objections and rejections of the Office Action of December 28, 2004, having been obviated by amendment or shown to be inapplicable, withdrawal thereof is requested and passage of claims 1-21 to issue is solicited.

Respectfully submitted,

A handwritten signature in cursive script, reading "Francis J. Maguire". The signature is written in black ink and is positioned above the printed name.

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